REMARKS

Claims 1 – 30 are pending in this application. Claims 7 and 8 have been canceled.

Claims 2 – 9 have been rejected under 35 USC 112, first paragraph, for failing to comply with the enablement requirement. This rejection is respectfully traversed. The Office Action gives five reasons for this rejection, each of which will be discussed below.

The Office Action states the relative skill in the art and the predictability of the art as a basis for the rejection. It also mentions the various ingredients have varying degrees of effect and different dosages, and given the great diversity between the various ingredients as somehow forming a basis for the rejection, but what this basis is is not clear. However, in fact, each of the various weight loss compositions that are disclosed is either a known commercial product, such as Orlistat, Chitol, etc., or the amounts of each ingredient are specified. For the known commercial products, the manufacturer always provides extensive information regarding the amounts to be used, and the application tells the reader to use the amounts indicated by the manufacturers. See page 11, line 1; page 12, line 5; and elsewhere. For each of the weight loss compositions which are not a well-known commercial product, a significant amount of direction is given. First, it is specified that the amount of the ingredients listed is to be used in a twelve- to fifteen-ounce bottle of salad dressing. See page 7, lines 21 and 22. Then it is indicated that the weight loss salad dressings are designed so that two ounces of dressing is used on a serving. See page 7, lines 25 and 26. Then it is stated that it is assumed that two salads are to be eaten a day to provide the effective daily amounts of the weight loss compound. Finally, for each ingredient that is not a well-known commercial product, the amount of the ingredient that should be put in a twelve- to fifteen-ounce bottle is given. See, for example, page 10, lines 22 – 29; page 11, lines 12 – 31, etc. The directions are equivalent to the directions given in a recipe book, and any good cook can easily follow them. Just as it does not take a Ph.D. to figure out that if a recipe is stated to make six servings that you would cut the ingredients in half for three servings or double them for twelve servings, so it does not take a Ph.D. to figure out how to adjust the recipes given, say for people who eat only one serving of salad a day, or for people who mostly eat salad. The Office Action also states that the application does not give sufficient guidance as to the amount of salad dressing used in each meal and the number of times to be used daily. As indicated above, this is not correct. See page 7, lines 21 – 31. The application

even gives guidance as to how to adjust for taste variations, and how to mix the ingredients. See page 20, line 23 through page 21, line 24.

The Office Action also states that the breadth of the claims is a reason for rejection, suggesting that they must include an active ingredient. However, based on the prior art provided thus far, the present application is the first disclosure of the combination of a weight loss composition with a salad dressing. Once this is disclosed, others can create variations, particularly since so many different variations are disclosed in the application. If an active ingredient were added to the claims, then others could easily design around the claim using the disclosure itself, and the Applicants would not gain the full benefit of what is disclosed and the protection to which they are entitled.

The Office Action also states that the amount of direction or guidance provided and the presence or absence of working examples is a basis for the rejection. Counting only the examples in which specific working amounts are provided, there are 42 different working combinations of salad dressing base and weight loss composition given. If the commercial products for which the manufacturer provides effective dosages are included, the number of working combinations are in the several hundreds. There is no case law that rejects claims when so many working examples are given.

The Office Action also cites the quantity of experimentation, and refers to an alleged confusion created by the application. The application gives precise cookbook-type directions for 42 different combinations of salad dressing and weight loss supplement. No experimentation is required for these examples. In addition, it gives directions for hundreds of other examples for which specific, detailed information is readily available from the manufacturers of the weight loss products specified. The Office Action seems to be using the great amount of directions provided against the Applicants by saying confusion would be created by possible combinations of the various weight loss ingredients. Of course, one can always deviate from the directions given in a cookbook, for instance by trying to make spaghetti soup or chocolate mousse cake, and create the need for experimentation, but this is not the type of experimentation the law is talking about. It is hard to see how, in the perspective of the case law, the law regarding undue experimentation would apply to the present specification and claims. *In re Wands*, 8 USPQ2d 1400, cited in the Office Action, found that undue experimentation was not required if the ingredients can be obtained from

readily available sources or readily available starting materials (*Wands*, at 1403), which certainly is the case here. *Ex parte Foreman*, 230 USPQ 547 (BdApls 1986), also cited in the Office Action, found undue experimentation would be required because one of ordinary skill in the art would not be able to obtain the specific S. typhi mutant strains required as starting materials by the claims, and the procedure to produce the strains was not well known. (*Foreman*, at 547). In contrast here, all of the starting materials are well known and readily available.

For the above reasons, claims 2 – 9 are patentable under 35 USC 112, first paragraph.

Claims 2 – 7 have been rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. The Office Action maintains that the fat blocker, carbohydrate blocker, appetite suppressant, metabolizer, weight loss stimulant, and nutrient partitioning modulator are not further described by the specification or further limited by the claims. This rejection is respectfully traversed.

With respect to claim 2, the specification gives five examples of a fat blocker weight loss supplement and 35 examples of the combination of a fat blocker with a salad dressing.

With respect to claim 3, the specification gives two examples of a carbohydrate blocker and 14 examples of a combination of a carbohydrate blocker with a salad dressing.

With respect to claim 4, the specification gives one example of a carbohydrate and fat blocker and 6 examples of the combination of a carbohydrate and fat block with a salad dressing. If one includes also the combinations of fat blockers and carbohydrate blockers, the specification includes at least 7 fat blocker and carbohydrate blocker combinations (or 42 examples if all of the fat blockers are combined with all of the carbohydrate blockers) and 49 examples of a combination of a carbohydrate and fat blocker with a salad dressing.

With respect to claim 5, the specification gives 5 examples of an appetite suppressant and 35 examples of the combination of an appetite suppressant with a salad dressing.

Claims 6 and 7 have been combined because metabolizer and thermogenic agents were combined in the discussion in the specification, since these are different words for the same thing.

The specification gives 6 different examples of a metabolizer/thermogenic agent and 42 examples of the combination of a metabolizer/thermogenic agent with a salad dressing.

Claim 8 has been canceled because it is redundant with claim 5.

With respect to claim 9, the specification provides 4 pages of detailed explanation of various nutrient partitioning modulators and the functions of each ingredient of a nutrient partitioning modulator (see page 12, line 8 through page 16, line 5), 3 examples of a nutrient partitioning modulator, and 21 examples of the combination of a nutrient partitioning modulator/salad dressing combination.

As indicated above, the amount of each ingredient necessary to be put in a specific amount of salad dressing for creating a weight loss product is given in detail, or the amounts necessary for weight loss are given in detail by the manufacturer. There is no reason why these amounts would not work to produce weight loss. For these reasons, claims 2 – 6 and 9 are patentable.

Claim 1 has been rejected under 35 USC 102(b) as being anticipated by Sundram et al. (US Patent Application Publication No. 20020034562, hereinafter "Sundram"). This rejection is respectfully traversed. Sundram relates to a fat composition that increases HDL and HDL/LDL concentration in humans. The only mention of weight loss in Sundram that the undersigned has been able to find is in paragraph 30. Here, the fat composition is mentioned only as a means of managing and controlling food intake. It does not explain any more than this, but from the rest of the disclosure this would be by managing or controlling the intake of fats. Those skilled in the art would not consider this to be a weight loss supplement. Further, the specification specifically defines "weight loss supplement" as used in the claims not to include diet ingredients such as low-fat or light formulations or sugar substitutes. See page 6, lines 22 – 25. Further, it is well known that one can increase HDL and HDL/LDL concentration in the blood without weight loss. By use of a drug prescribed by his physician, the undersigned, as well as millions of other people, has increased his HDL and HDL/LDL ratio by about 40% without losing a single pound. Sundram does not teach the combination of a salad dressing and a weight loss composition. Thus, Sundram does not anticipate claim 1.

Claims 1 – 30 have been rejected under 35 USC 103(a) as being unpatentable over Sundram et al. (US Patent Application Publication No. 20020034562, hereinafter "Sundram") in view of McCleary (US Patent No. 6,579,866, hereinafter "McCleary"), Hastings (US Patent No. 5,626,849, hereinafter "Hastings"), and further in view of Dente (US Patent No. 6,277,396, hereinafter "Dente"). This rejection is respectfully traversed. As pointed out above, Sundram does not teach anything about weight loss supplements as defined in the specification. McCleary teaches a weight loss supplement, but does not mention its use in salad dressing or any other food. Hastings also teaches a weight loss supplement, and mentions that it can be incorporated into foods such as candy, cakes, cookies, and candy bars. However, it does not mention salad dressing. Dente discloses a fat burning dietary supplement, but does not mention its use in a salad dressing.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991). MPEP 2142 and MPEP 2143 – 2143.03. Here, the suggestion to put a weight loss supplement in a salad dressing only comes from the present disclosure, not any of the references or the combination thereof. Thus, claims 1, 12, 14, and 26 are patentable. Claims 2 – 6, 9 – 11, 13, 15 – 25, and 27 – 30 each depend on a patentable claim and, therefore are also patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4.

Claims 1 – 9, 12 – 23, and 25 – 30 have been rejected on the ground of nonstatutory double patenting over claims 1 – 9 and 14 – 24 of US Patent No. 6,579,866 (McCleary). This rejection is respectfully traversed. None of the claims of McCleary include the combination of a salad dressing with a weight loss supplement; therefore, the present claims are patentably distinct from all the claims of McCleary. The Office Action states that there is no apparent reason why Applicants were prevented from presenting claims in McCleary corresponding to those in the present application. However, the reason is obvious: this was not possible, since McCleary disclosed nothing about combining the McCleary weight loss supplement with a salad dressing.

Claims 1 – 9, 11 – 23, and 25 – 30 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 7, 9, 14 – 19, 21 – 25, 27, and 29 – 32 of copending US Patent Application No. 10/987,108. This rejection is respectfully traversed. All of the claims of the 10/987,108 application include the following subject matter that is not in any of the claims of the present application and is patentably distinct from the claims of the present application: an effective amount of one or more ingredients selected from the group consisting of: medium chain triglycerides (MCT) with fatty acid backbones containing 6 to 14 carbon atoms or their individual fatty acid analogues or metabolic precursors, sesame seeds or their derivative products, sesamin and/or its epimer episesamin, caffeine, forskolin, 7-keto dehydroepiandrosterone (7-keto DHEA), green tea extract containing epigallocatechingallate (EGCG), capsaicum, and 5-hydroxytryptophan (5-HTP).

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. A Request for a One-Month Extension of Time and the required fee is enclosed. Applicants believe no additional fee is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 50-1848, under Order No. 023604.0102PTUS from which the undersigned is authorized to draw.

Respectfully submitted,
PATTON BOGGS LLP

Dated: January 18, 2007

By: _____
Carl A. Forest
Registration No.: 28,494
(303) 894-6114
(303) 894-9239 (Fax)
Attorney for Applicants

Customer No. 24283